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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,031	06/25/2001	Paul H. Katz	50563CON1	9956
7590 03/11/2005				
Christopher F. Regan Allen, Dyer, Doppelt, Milbrath, Gilchrist, P.A. P.O. Box 3791 Orlando, FL 32802-3791			EXAMINER JUNG, MIN	
			ART UNIT 2663	PAPER NUMBER

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,031

Applicant(s)

KATZ ET AL.

Examiner

Min Jung

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6-25-01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 43-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-25, and 13 of U.S. Patent No. 6,256,294 ('294).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the overlap mode ISDN dialing and the enbloc mode ISDN dialing depending on the OFF/ON HOOK condition are claimed in the '294 patent. The present claims (claim 43 and 52, for example) recite both OFF HOOK situation and ON HOOK situation in each respective claim. Although the patented claims recite the two different situations (overlap mode dialing in OFF HOOK condition, and enbloc mode dialing in ON HOOK condition) in two different sets of claims, the different modes of dialing is specifically recited with each situation claimed. The exemplary claims 17, 24,

Art Unit: 2663

and 25 of '294 patent all recite a dialing mechanism that includes overlap mode ISDN dialing and enbloc mode ISDN dialing making it operative to selectively place a call in accordance with either mode of dialing. Claim 17 then further recites the situation of overlap mode dialing used in OFF HOOK condition, and claim 24 further recites the situation of enbloc mode dialing used in ON HOOK condition. Therefore, it would have been obvious for one of ordinary skill in the art to combine the two situations claimed in claims 17-23 and 24-25 to make a method and apparatus which is operative in both situations of OFF HOOK condition and ON HOOK condition to selectively provide both situations in one method/apparatus.

Further, the dependant claims 44-51 and 53-60 adds the similar limitations recited in a portion of claim 17 and claims 18-25 of '294 patent. Because the present claims are combination of two situations, which were separately claimed in the patent, the dependant claims naturally add the operational steps, which involve two different situations. For example, claim 45 recites "said enbloc mode ISDN dialing is operative, when executed in step (b), to transmit an enbloc mode call set-up message containing identifications of all of the digits of a called number". This same limitation is included as a part of claim 24 in the patent. It would have been obvious for one of ordinary skill in the art at the time of the invention to add an operational step for the ON HOOK/enbloc mode situation, which is already known by the patented claim. The rest of the dependant claims recite the limitations which are all obvious mix and match of the patented claims, and therefore, it would have been obvious fro one of ordinary skill in

Art Unit: 2663

the art to apply them in the present claims reciting both OFF HOOK situation and ON HOOK situation.

Therefore, the present claims reciting both situations in each of the claim sets (43-51, and 52-60) are not patentably distinct from the patented claim sets.

Further, claim 61 recites a method that closely resembles the method of claim 13 of '294 patent. Claim 61 is different from the patented claim 13 in that the present claim leaves out the coupling step. However, coupling a ISDN telecommunication device to the communication circuit is an inherent step in claim 61 since an ISDN device has to be coupled in order for the ISDN qualifying test (method of determining whether a communication circuit is qualified for ISDN signaling) to be performed. Therefore, it would have been obvious for one of ordinary skill in the art to specifically provide a coupling step to couple an ISDN device to the communication circuit so that qualification test can be performed using the device.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Thompson et al. patent is cited for further reference.


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 571-272-3127.

The examiner can normally be reached on Monday, Thursday, Friday 7:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
March 4, 2005


Min Jung
Primary Examiner